

REMARKS

Claims 1- 23 and 29 - 52 are presently before the examiner. Claims 1 - 5, 8, 9, 12 - 16, 35 and 50 have been canceled without prejudice to reclaiming the subject matter therein at a later date.

Information Disclosure Statement

The examiner states in the Office Action that References C1 - C6 and C8 of the IDS submitted on 29 January 2003 have not been considered because they were not provided with the application and the parent file is not available. The examiner then invited applicant to supply copies of the missing references.

Applicant's response

Copies of the missing references are provided herewith.

Double patenting rejection

The examiner has rejected all claims under the judicially created doctrine of obviousness-type double patenting over claims 1 - 20 and 29 - 39 of U.S. Pat. No. 6,500,431. In the examiner's opinion, the claims of the current application, although not identical to the claims of the '431 application, comprise a species encompassed by the genus claimed in the '431 patent.

Applicant's response

Submitted herewith is a terminal disclaimer disclaiming any portion of the term of a patent that may issue from this application that exceeds the natural term of the '431 patent.

Objection to claims 7 - 9 and 11- 22

The examiner has objected to claims 7 - 9 and 11 - 22 as being improper dependent form for failing to further limit the subject matter of the previous claim.

Applicant's response

Claims 7 and 11 has been rewritten independent form. Claims 8, 9 and 12 - 16 have been canceled. All claims are, applicant believes in proper claim form. The examiner is requested to withdraw the objection.

35 U.S.C. § 112, second paragraph rejection of claims 29 - 36 and 45 - 52.

The examiner has rejected claims 29 - 36 and 45 - 52 under § 112, first paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant considers as the invention. In particular, the examiner is of the opinion that the phrases "said organism" in claim 29 and "said cell targeting moiety" in claim 45 lack antecedent basis.

Applicant's response

Claims 29 and 4 have been amended to more clearly point out that which applicant considers as the invention. The examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 112, first paragraph, rejection of claims 1 - 3, 5 - 8, 10 and 40 - 52

The examiner has rejected claims 1 - 3, 5 - 8, 10 and 40 - 52 under § 112, first paragraph, because, in the examiner's opinion, the specification does not reasonably provide enablement for polypeptides comprising the sequence DXCXD, where X is any amino acid. Furthermore, claim 5 is drawn to peptidomimetics of DXCXD, while claims 40 - 52 are drawn to fusion proteins comprising the sequence DXCXD, which the examiner rejects for the same reason - in the examiner's opinion, lack of reasonable enablement.

Applicant's response

Claims 1 - 3, 5 and 8 have been canceled without prejudice to re-claiming the subject matter therein at a later date. Claims 6, 7, 10 and 40 have been amended. The rejection is thereby rendered moot and the examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 112, first paragraph rejection of claims 1 - 3, 6 - 8, 10, 29 - 34 and 36 - 52

The examiner has rejected claims 1 - 3, 6 - 8, 10, 29 - 34 and 36 - 52 under § 112, first paragraph because, in the examiner's opinion, the specification fails to adequately describe the invention in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the invention. The basis set forth by the examiner for the rejection was that the

specification does not provide an adequate description of the genus of polypeptides comprising the sequence DXCXD.

Applicant's response

Claims 1 - 3 and 8 have been canceled without prejudice to reclaiming the subject matter therein at a later date. Claims 6, 7, 10, 29 and 37 have been amended to more clearly point out that which applicant considers as the invention. The cancellations and amendments render the rejection moot. The examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 112, first paragraph rejection of claim 5

The examiner has rejected claim 5 under § 112, first paragraph, because, in the examiner's opinion, the specification does not adequately describe the peptidomimetics claimed in claim 5.

Applicant's response

Claim 5 has been canceled without prejudice to reclaiming the subject matter therein at a later date. The examiner is requested to withdraw the rejection.

35 U.S.C. § 102(e) rejection of claims 1 - 6, 8, 9, 11 - 23 and 37 - 39

The examiner has rejected claims 1 - 6, 8, 9, 11 - 23 and 37 - 39 as being anticipated by Hammerstedt, U.S. Pat. 5,910,568. In the examiner's opinion, Hammerstedt's SEQ. ID. Nos. 4, 5 and 15 are species of the sequences claimed in the rejected claims and thereby anticipate those claims.

Applicant's response

Claims 1 - 5, 8 and 9 have been canceled without prejudice to reclaiming the subject matter therein at a later date. Claims 11 and 37 have been amended to more clearly point out that which applicant considers as the invention. The cancellations and amendments render the rejection moot. The examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 102 rejection of claims 1 and 10

The examiner has rejected claims 1 and 10 under § 102(b) as being anticipated by Stevens, et al., Biochemistry (1993), 32:4051 - 59. In the examiner's view, Stevens

discloses a peptide sequence of 79 amino acids comprising a DXCXD sequence and further teaches that the peptide may be glycosylated.

Applicant's response

Claim 1 has been canceled without prejudice to reclaiming the subject matter therein at a later date and claim 10 has been amended. The cancellation and amendment render the rejection moot. The examine is requested to reconsider and withdraw the rejection.

35 U.S.C. § 102 rejection of claims 29, 30, 33 - 35, 37, 40 and 41

The examine has rejected claims 29, 30, 33 - 35, 37, 40 and 41 under § 102(b) as being anticipated by Katz, U.S. Pat. No. 5,716,614. In the examiner's opinion, the lack of an antecedent basis for "said organism" means that claims 29, 30 and 33 - 35 are not limited to methods of administering to a mammal having a disease associated with angiogenesis and Katz teaches administration of Saposin B for the treatment of metachromatic leukodystrophy, which anticipated the claims as written.

Applicant's response

Claim 29 has been amended, claims 30, 33 - 35 depend from claim 29. Claims 37 and 40 have likewise been amended and claim 41 depends from claim 40. The amendments render the rejection moot. The examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 102 rejection of claims 1, 2, 5 and 11

The examiner has rejected claims 1, 2, 5 and 11 under § 102(b) as being anticipated by Dean, U.S. Pat. No. 5,888,474 in that Dean teaches a labeled peptide that comprises the sequence DVC GD, is 10 amino acids in length and therefore is a species of the genus claimed in the rejected claims.

Applicant's response

Claims 1, 2 and 5 have been canceled without prejudice to reclaiming the subject matter therein at a later date. Claim 10 is dependent on claim 11, which has been amended, the amendment rendering the rejection moot. The examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 102 rejection of claims 1, 5 and 10

The examiner has rejected claims 1, 5 and 10 under § 102(b) as being anticipated by Tripp, U.S. Pat. No. 5,639,876. In the examiner's opinion, SEQ. ID. No. 5 in the Tripp patent comprises the sequence DDCGD, is 9 amino acids in length and may be glycosylated which reads on the sequences in the rejected claims.

Applicant's response

Claims 1 and 5 have been canceled without prejudice to reclaiming the subject matter therein at a later date. Claim 10 depends from claim 11, which has been amended thereby rendering the rejection moot. The examiner is requested to reconsider and withdraw the rejection.

35 U.S.C. § 102 rejection of claims 1, 5 and 10

The examiner has rejected claims 1, 5 and 10 under § 102(b) as being anticipated by Luster, U.S. Pat. No. 6,403,782 in that Luster teaches a polypeptide comprising the sequence DICAD (SEQ. ID. NO. 25), is 74 amino acids in length and may be glycosylated. In the examiner's view, this polypeptide is the same as that claimed in the instant application.

Applicant's response

Claims 1 and 5 have been canceled without prejudice to reclaiming the subject matter therein at a later date. Claim 10 depends from claim 11, which has been amended thereby rendering the rejection moot. The examiner is requested to reconsider and withdraw the rejection.

CONCLUSION

Based on the amendments attached hereto and above remarks, applicant believes that claims 6, 7, 10, 11, 17 - 23, 29 - 34, 36 - 49, 51 and 52 are in condition for allowance and requests that they be passed to issue.

Applicant hereby requests a 2 month extension in time to reply to the Office Action addressed herein. The commissioner is authorized to charge the fee for such extension to Bingham McCutchen Deposit Account No. 50-2518, referencing attorney docket no. 2013761-7000622002.

Please address all correspondence regarding this communication to:

Bernard F. Rose, Esq.
Bingham McCutchen LLP
Three Embarcadero Center, Suite 1800
San Francisco, CA 94111-4067
Telephone: (650) 849-4902
Facsimile: (650) 849-4800
bernie.rose @ bingham.com

Date: October 27, 2004

Respectfully submitted,
Bingham McCutchen LLP

By: _____


Bernard F. Rose, Esq.
Registration No. 42,112